

Appl. No. 10/628,531

November 12, 2005

Reply to Office Action of August 12, 2005

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II. REMARKS

Claims 1 through 35 were originally filed in this application. Claims 36 through 40 were subsequently added. Claims 1, 12, 36, and 40 were previously cancelled without prejudice, and claims 17 through 35 were previously withdrawn with traverse as a result of an earlier restriction requirement. Claims 2, 3, 5-8, 10, 13, 15, 16, 37, and 38 were rejected herein. Claim 37 was amended herein to more clearly define the claimed subject matter and thereby place all of the claims remaining in the application in condition for allowance. Claim 41 was added herein to combine the subject matter of previously cancelled claims 36 and 40. Thus, claims 2 through 11, 13 through 16, 37 through 39, and 41 are pending in the present application.

No new matter is presented in the amendments to the claims, and such amendments are deemed unobjectionable. Entry thereof is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

A. Allowed Claims

Applicant gratefully acknowledges the Examiner's allowance of claim 39.

B. Correction Of The Record Regarding Previous Allowability Of Claims

It is noted that the Examiner withdrew the indicated allowability of claims 2-11, 13-16, and 37-39 based on a "newly" discovered reference to Rivard et al. For the record, the Rivard et al. reference was known and cited in the first Office Action (on PTO Form 892 prepared by the Examiner) at which time claims 3, 4, 9, 11, and 14-16 were indicated to contain allowable subject matter. In the second Office Action, claims 3, 4, 9, 11, and 14-16 were again considered allowed along with claims 2, 5-8, 10, 13, and 37-39. It was not until this third Office Action that the Examiner withdrew the allowance to all of these claims

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except claim 39. It is respectfully asserted that the Examiner has not met the obligation under MPEP 706.04 to exercise great care in authorizing a rejection of previously allowed claims as argued below.

C. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 2, 3, 6, 10, and 37 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 3,146,559 to Wilkinson ("Wilkinson") in view of the teachings of U.S. Patent 6,262,164 to Rivard et al. ("Rivard"). The Office Action also rejected claims 5, 7, 8, 13, 15, 16, and 38 under 35 U.S.C. § 103 as being unpatentable over Wilkinson in view of the teachings of Rivard, and further in view of the teachings of U.S. Patent 4,570,388 to Tano et al. ("Tano"). Applicant respectfully traverses each of the 35 U.S.C. § 103 rejections set forth herein for the reason that Applicant's invention is patentably distinguishable, and not an obvious improvement, over the cited references.

The Office Action does not set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness according to MPEP § 706.02(j), (a) cited references must teach or suggest all of Applicant's claim limitations, (b) there must be some suggestion to modify or combine reference teachings, and (c) there must be a reasonable expectation of success in modifying or combining the cited references.

1. Cited References Are Missing Elements Of Applicant's Claims

a. Wilkinson and Rivard

Foremost, it is apparent that the cited references do not teach or suggest all of Applicants claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine the cited references, there are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that

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all of the claim limitations of Applicants invention are not met by Wilkinson or Rivard or any combination thereof.

Claims 2, 3, 6, 10, and 37

Applicant's independent claim 2 recites, *inter alia*, a plurality of floor finishing units positioned in a tandem arrangement on said frame, wherein at least one of said plurality of floor finishing units includes an abrasive grit different from at least one other of said plurality of floor finishing units.

The Office Action generally alleges that Wilkinson suggests the claimed invention of claims 2, 3, 6, 10, and 37, except that Wilkinson "does not disclose one floor finishing units includes abrasive grit different from other floor finishing unit". The Office Action goes further and alleges that Rivard discloses that "a floor finishing unit includes different abrasive grit." (emphasis added) But this is very different from different floor finishing units using different abrasive grits as required by Applicant.

The Office Action also alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to "modify the sanding machine of Wilkinson with an abrasive unit including different abrasive grit in order to provide a simple and versatile arrangement for varying abrasive characteristic to a workpiece". (see Office Action page 2)

The Applicant respectfully disagrees with the above allegations because there are significant structural and functional differences between Applicant's invention and Wilkinson, or Rivard, or any combination thereof. First, Wilkinson fails to disclose, teach, or suggest at least one of a plurality of floor finishing units including an abrasive grit different from at least one other of the plurality of floor finishing units. Second, Rivard fails to disclose, teach, or suggest a plurality of floor finishing units positioned in a tandem

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arrangement on a frame. Third, Rivard fails to show using one abrasive grit on one floor finishing unit and a second different abrasive grit on a second floor finishing unit.

Fourth, any combination of Wilkinson and Rivard fails to disclose, teach, or suggest a plurality of floor finishing units positioned in a tandem arrangement on a frame, wherein at least one of the plurality of floor finishing units includes an abrasive grit different from at least one other of the plurality of floor finishing units. At best, the combination of Wilkinson and Rivard would yield use of the Rivard multi-abrasive pad for use on all pads of the Wilkinson device. In other words, Wilkinson and Rivard do not disclose separate floor finishing units having different abrasive grits.

Therefore, notwithstanding the fact that the combination of the Wilkinson and Rivard references as suggested by the Office Action is not legally justified as will be discussed below, Applicant's claims 2, 3, 6, 10, and 37, would still have novel and unobvious physical features over the proposed combination. In other words, any attempt at modifying or combining the cited references does not disclose all of the claimed features of Applicant's invention and, therefore, the combination would necessarily constitute a different structure and different result than the claimed invention.

b. Wilkinson, Rivard, And Tano

Foremost, it is apparent that the cited references do not teach or suggest all of Applicants claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine the cited references, there are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that all of the claim limitations of Applicants invention are not met by Wilkinson, Rivard, and/or Tano, and/or any combination thereof.

Claims 5, 7, and 8

Applicant's claim 5, 7, and 8 each recite, *inter alia*, a plurality of floor finishing units mounted to a frame and positioned in a tandem arrangement, wherein at least one of the plurality of floor finishing units includes an abrasive grit different from at least one other of the plurality of floor finishing units.

The Office Action generally alleges that a combination of Wilkinson and Rivard suggests the claimed invention of claim 5, 7, and 8, except for floor finishing units pivotably mounted to a frame which the Office Action further alleges is disclosed by Tano. The Office Action also alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Wilkinson machine, as modified by Rivard, with a frame as disclosed by Tano in order to provide a stable and uniform cleaning operation (see Office Action page 3).

The Applicant respectfully disagrees with the above allegations because there are significant structural and functional differences between Applicant's invention and Wilkinson, Rivard, and/or Tano, and/or any combination thereof. First, for the reasons previously set forth above with respect to the rejection of claim 2, Wilkinson, Rivard, and/or any combination thereof fails to disclose, teach, or suggest a plurality of floor finishing units mounted to a frame and positioned in a tandem arrangement, wherein at least one of the plurality of floor finishing units includes an abrasive grit different from at least one other of the plurality of floor finishing units. Second, the deficiencies of Wilkinson, Rivard, and/or any combination thereof are not overcome by the proposed combination with Tano, because Tano fails to disclose, teach, or suggest at least one of a plurality of floor finishing units including an abrasive grit different from at least one other of the plurality of floor finishing units.

Third, any combination of Tano with the Wilkinson/Rivard combination still fails to disclose, teach, or suggest a plurality of floor finishing units positioned in a tandem arrangement on a frame, wherein at least one of the plurality of floor finishing units includes an abrasive grit different from at least one other of the plurality of floor finishing units. In other words, Wilkinson, Rivard, and/or Tano do not disclose separate floor finishing units having different abrasive grits.

Claims 13, 15, 16, and 38

Applicant's claims 13, 15, and 16 each recite, *inter alia*, a frame for use in combination with a floor finishing unit, wherein the frame comprises a strut, a beam attached to the strut, and a link attached to the beam, wherein the link is pivotably mounted to the beam. Applicant's claim 38 recites, *inter alia*, a plurality of floor finishing units including a plurality of bosses thereon and pivotably mounted to a frame by a plurality of links pivotably mounted to the frame.

The Office Action generally alleges that some combination of Wilkinson and Rivard suggests the claimed invention of claims 13, 15, 16, and 38 except for floor finishing units pivotably mounted to a frame including a strut, an upright attached to the strut, a cross-member attached to the strut, and a link attached to the cross-member, all of which the Office Action alleges is disclosed by Tano. The Office Action also alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Wilkinson machine, as modified by Rivard, with a frame as disclosed by Tano in order to provide a stable and uniform cleaning operation (see Office Action page 3).

The Applicant respectfully disagrees with the above allegations because there are significant structural and functional differences between Applicant's invention and any combination of Wilkinson, Rivard, and/or Tano.

The Tano reference appears to disclose a truck 1 comprised of a frame including beams 3, 4, a holding arm 16 ("beam" per Office Action) fixed at one end to the truck 1, and a holding cylinder 17 ("link" per Office Action) fixed to another end of the holding arm 16 (col. 2, lines 55-60). Tano appears to teach use of a cleaner 11 that is loosely fit within and, therefore tiltable with respect to, the holding cylinder 17.

But nowhere in the Tano reference is there any disclosure regarding the holding cylinder 17 (link) being pivotably mounted to the holding arm 16 (beam). Rather, Tano specifically discloses that the holding cylinder 17 (link) is fixed to the holding arm 16. A "fixed" link is very different from a "pivotable" link and, therefore, independent claim 13 is thereby distinguishable over the Tano reference.

Therefore, notwithstanding the fact that the combination of the Tano reference with the Wilkinson/Rivard combination as suggested by the Office Action is not legally justified as will be discussed below, Applicant's claims 5, 7, 8, 13, 15, 16, and 38 would still have novel and unobvious physical features over the proposed combination. In other words, any attempt at combining the cited references does not disclose all of the claimed features of Applicants invention and, therefore, the combination would necessarily constitute a different structure and different result than the claimed invention.

2. No Basis to Combine the Cited References And No Reasonable Expectation Of Success In Doing So

One of ordinary skill in the art would have no basis for combining the teachings of Wilkinson, Rivard, and/or Tano in order to attempt to replicate Applicant's invention, because there is no suggestion or motivation in the art to do so. It is well settled patent law that a sustainable obviousness rejection requires "some teaching, suggestion, or motivation to combine the references," as summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). *See also Robotic Vision Systems, Ind. v. View*

Engineering, Inc., 51 USPQ2d 1948 (Fed. Cir. 1999). The initial burden to point out the suggestion in the prior art for the desirability of doing what the inventor has done, is on the Examiner. MPEP § 706.02(j) More specifically, the Examiner must set forth the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here, the Office Action lacks a proper *prima facie* showing of obviousness since the Office Action does not provide any teaching, suggestion, or motivation for combining the cited references, other than the conclusory statement that "it would have been obvious...in order to provide a simple and versatile arrangement for varying abrasive characteristic to a workpiece." The Office Action neither sets forth any specific proposed modifications of the Wilkinson, Rivard, and/or Tano references necessary to combine them and arrive at the claimed subject matter, nor any principle or specific understanding within the level of ordinary skill in the art that would have motivated a skilled artisan to combine the references.

Applicants respectfully submit that the Office Action's lack of an indication anywhere in the record of a finding in the cited references of a suggestion for the desirability of the proposed combination, militates against an obviousness rejection of Applicant's invention as claimed.

Furthermore, one of ordinary skill in the art of floor sanding machines would not attempt to combine the references to yield the Applicant's invention in the manner

suggested in the Office Action, because the suggested combination is technologically incorrect, and would not result in Applicant's invention without further unsuggested modifications. At best, the suggested combination would result in a floor finishing machine having a plurality of tandem floor finishing units, with each floor finishing unit carrying identical abrasive assemblies including two different abrading surfaces, but would not result in multiple floor finishing units having abrasive grits different from one another. Simply put, the combination of Wilkinson and Rivard to yield Applicant's invention would be impossible such that a person of ordinary skill in the art would certainly not consider altering or combining the Wilkinson, Rivard, and/or Tano references as alleged in the Office Action.

Notably, the Office Action does not propose any specific modifications of each of the Wilkinson, Rivard, and/or Tano references that would be necessary to successfully combine the references to arrive at the claimed subject matter. Applicants assert that this failure is evidence that such a combination is not reasonably desirable or feasible, which militates against the obviousness rejection of Applicant's invention.

In view of a lack of suggestion from the Office Action and from the cited references, a person of ordinary skill in the art would not seek to modify or combine these references cited in the Office Action to produce the results that Applicant's invention teaches. It is only through Applicant's own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a plurality of floor finishing units positioned in a tandem arrangement on said frame, wherein at least one of said plurality of floor finishing units includes an abrasive grit different from at least one other of said plurality of floor finishing units. In other words, but for Applicant's disclosure, there is no teaching, suggestion, or motivation whatsoever to combine Wilkinson, Rivard, and/or Tano in any way in order to

obviate Applicant's invention. Accordingly, Applicant respectfully asserts that the Office Action is an example of hindsight reconstruction in an attempt to obviate Applicant's invention after having the benefit of reading Applicant's disclosure. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the cited references to deprecate the claimed invention. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The teachings or suggestions to make the claimed combination or modification and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *See In re Vaack*, 20 USPQ2d, 947 F.2d 488, (Fed. Cir. 1991).

3. Summary

Applicant's invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, the cited references fail to disclose, teach, or even suggest either 1) a plurality of floor finishing units positioned in a tandem arrangement on said frame, wherein at least one of said plurality of floor finishing units includes an abrasive grit different from at least one other of said plurality of floor finishing units, or 2) a frame for use in combination with a floor finishing unit, wherein the frame comprises a strut, a beam attached to the strut, and a link attached to the beam, wherein the link is pivotably mounted to the beam. Thus, independent claims 2, 10, 13, 37, and 38 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, dependent claims 3, 6, 7, 8, 15, and 16 are not rendered obvious either. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

For the reasons above, new claim 41 combining cancelled claims 36 and 40 to recite a plurality of floor finishing units pivotably mounted to a frame by a plurality of links pivotably mounted to the frame, and a jack attached to the frame, is also unobvious and patentable.

III. CONCLUSION

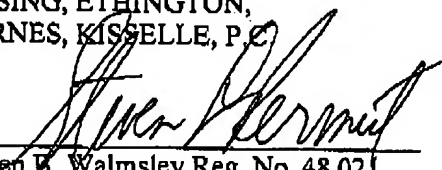
In view of the foregoing remarks, the Applicant respectfully submits that the pending independent and dependent claims are in proper form, define patentably over the cited references, and are all allowable. Applicant, therefore, respectfully requests that the Examiner's objections and rejections under 35 U.S.C. § 103 be reconsidered and withdrawn and that a formal and timely Notice of Allowance of the application be issued.

If the Examiner is not persuaded that all issues are resolved, the undersigned respectfully requests that the Examiner initiate a telephone interview to enable an attempt to be made to resolve any remaining issues.

If the Examiner has any questions with respect to any matter now of record, the Applicant's attorney may be reached at the telephone number below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 50-0852.

Respectfully submitted,

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